

**REMARKS**

Claims 1 through 6 are pending in this Application. Applicants acknowledge, with appreciation, the Examiner's allowance of claims 3, 5 and 6. Accordingly, the only remaining issue pivots about the patentability of claims 1, 2 and 4.

**Claims 1, 2 and 4 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Otake in view of Daniel et al.**

In the Amendment submitted April 29, 2004, Applicant argued, and the Examiner now clearly **admits**, that the semiconductor device disclosed by Otake does not have first and second field-effect transistors sharing a common source region. Rather, as apparently appreciated by the Examiner, in Otake's device the transistors share a common **drain**.

Nevertheless, the Examiner concluded one having ordinary skill in the art would have been motivated to **proceed against** the teachings of Otake by modifying Otake's device to form first and second field-effect transistors sharing a common source region (not a common drain as Otake wants). The reason offered by the Examiner is that such a modification of Otake's device would achieve a reduction in circuit size and circuit consumption, based upon claim 18 and paragraph [0007] of Daniel et al. This rejection is traversed.

In order to establish the requisite motivational element, the Examiner must make clear and particular factual findings as to a specific understanding or specific technological principle and, based upon such factual findings, explain **why** one having ordinary skill in the art would have been realistically impelled to modify particular prior art, in this case the **particular device** disclosed by Otake et al., to arrive at the claimed invention. *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 63 USPQ2d 1374; *In re Lee*, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002);

*Ecolochem Inc. v. Southern California Edison, Co.*, 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); *In re Kotzab*, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). That burden has not been discharged. Specifically, the Examiner did not provide the requisite facts or fact-based reasoning to support the obviousness conclusion.

**Insufficient Facts.**

The Examiner's assertion that the proposed modification of Otake's device would achieve a reduction in circuit size and circuit consumption is **not supported by any facts**. In this respect Applicant stresses the Examiner did **not** specifically identify wherein Daniel et al. link claim 18 to the advantages recited in paragraph [0007]. If the Examiner is of the opinion that sharing a common region would necessarily reduce circuit size and circuit consumption, then the Examiner certainly did **not** factually establish that Otake's device is not already reduced in circuit size and circuit consumption by virtue of the transistors sharing a common drain.

If the Examiner is suggesting that one having ordinary skill in the art would have been motivated to modify Otake's device so that the first and second field-effect transistors would share **both a common source and a common drain**, then the Examiner is hereby requested to provide **objective evidence** establishing such motivation or that such a resulting device is even **feasible or workable**.

**There is no motivation.**

As previously argued, Otake's device contains first and second field-effect transistors sharing a common drain. That is because Otake wants the first and second field-effect transistors to

share a common drain because that is essential for the Double Diffused Metal Oxide Semiconductor (DMOS) disclosed by Otake. **If**, and that is a big **if** with which Applicant does **not** agree, one having ordinary skill in the art would have modified Otake's DMOS so that the first and second field-effect transistors would share a common source, such a modification is completely **antagonistic to Otake's disclosure**. This is because if the drain regions of Otake's DMOS are divided, the resulting device is not a DMOS which is what Otake wants. Under such circumstances, it is **inconceivable** that one having ordinary skill in the art would have been realistically motivated to modify Otake's DMOS so that the first and second field effect transistors would share a common source rather than a common drain. It is well said about one having ordinary skill in the art **cannot** be considered **realistically** motivated to modify a reference in a manner completely **inconsistent** with the express disclosure of that reference. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *In re Schulpen*, 390 F.2d 1009, 157 USPQ 52 (CCPA 1968).

## Conclusion

Based upon the foregoing it should be apparent that a *prima facie* basis to deny patentability to the claimed invention has not been established for lack of the requisite factual basis and want of the requisite realistic motivation. Moreover, there is a potent indicium of **nonobviousness** stemming from the **teaching away** from the claimed invention by **Otake** in requiring the transistors to share a common drain. *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986); *In re Marshall*, 578 F.2d 301, 198 USPQ 344 (CCPA 1978).

Clearly, one having ordinary skill in the art would **not** have found the claimed invention **as a whole** obvious within the meaning of 35 U.S.C. § 103. Applicant, therefore, submits that the imposed rejection of claims 1, 2 and 4 under 35 U.S.C. § 103 for obviousness predicated upon Otake in view of Daniel et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

It should, therefore, be apparent that the imposed rejection has been overcome and that all pending claims are a condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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